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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER POLTORAK, PIOTR	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 07/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,566

Applicant(s)

BACSO ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13, 17-19, 21, 23-40 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 9-11, 14-16, 20 and 22 is/are objected to.
- 8) ☒ Claim(s) 41-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In response to an election of Group I received on 5/16/2005, claims 1-40 and 48-53 have been examined. The claims in Group II have been withdrawn and should be canceled in response to this Office Action.

Priority

2. Foreign priority has been claimed in this application.
3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 11/20/2000.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Drawings

5. The drawings are objected to because objects 18 and 19 in Fig. A1 are not addressed in the specification. Also, Fig. 3-5 are not understood, as they seem to be copies of Fig. A1-A3. Furthermore, the examiner did not find a clear discussion in the specification regarding objects presented in Fig. 1-2 and Fig. 4-11. While amending the specification so that a reader has a clear understanding of where Fig. 1-2 and Fig. 4-11 are discussed, applicant should be consistent and

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make sure that all of the objects in Fig. 1-2 and Fig. 4-11 are clearly identified, e.g. by object numbers.

No new matter is allowed.

6. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 9-11, 14-16, 20 and 22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative and cannot depend from any other multiple dependent claim. See

MPEP § 608.01(n). Accordingly, claims 1, 9-11, 14-16, 20 and 22 have not been further treated on the merits.

8. "The convent viewing" in claim 1 seems to be misspelled. It should be changed to "the content viewing".
9. The "beindependently" cited in claim 14 seems to be misspelled "be independently".
10. Claim 53 lacks antecedent basis for the term "said use" (*see second paragraph of 35 U.S.C. 112, below*). It appears this may be a spelling error and is meant to state "said user".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
12. Claims 48-49 recite: "determining which versions of the content the receiver is permitted to access". However, the specification provides no guidance in teaching how this limitation is accomplished.

13. Similarly, applicant does not disclose the limitation recited in claim 49 of

“determining if permission is available to sue storage accessible to the receiver with characteristics ...”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-40 and ~~48~~⁴⁸ 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

15. Claims 9, 14, 21-23 and 33-34 uses terminology that is trademarked and/or not well defined with the version of the claimed subject. For example, OpenTV (*claim 23*) and MPEG (*claim 33*) have more than one version, and Kerberos (*claim 9*) meets both of these criteria.

16. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

trademark/trade name is used to identify/describe an operating system and, accordingly, the identification/description is indefinite.

17. Also providing a subject without the associated version does not allow the examiner to assess with certainty the metes and bounds of the claim limitations.

18. Applicant's capitalization of certain phrases e.g. "OPPORTUNITY TYPES" (*claim 2*) or "CONDITIONAL ACCESS" (*claim 6*) is not understood.

19. The significance of "local storage" placed in brackets in claim 49 is not understood.

20. Applicant's claims are replete with numerous language recitations that use the term "can". Applicant is reminded that the use of such a language is not a positive recitation. The examiner acknowledges that use of such a language only requires that a method have the capability to perform a particular function not that it actually performs them. Accordingly, the examiner has given nominal consideration to such limitations. For example, general purpose computers routinely make use of smart cards and transfer content characteristics.

21. Applicant uses jargon, but does not describe all of the terms within the specification and the claim limitations. In order to avoid confusion and for purposes of consistency applicant should describe appropriate terms corresponding to particular phrases, as applicant did in claim 21 with a direct-to-home satellite broadcasting system (DTH) for example.

22. In claims 1 and 53 the following lack antecedent basis:

- a. Claim 1: "the viewer",
- b. Claim 53: "said use".

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23. Applicant implements an inconsistent use of articles. For example in claims 1 and 2, there is an inconsistency. For example, applicant recites the term "a content" in claim 1, line 1 and follows it with "content" in line 13 without a preceding article, followed subsequently in lines 18 and 23 applicant refers to "the content". This inconsistency has an additional implication. For example it is not clear whether "the content viewing" in lines 23-24 and 27 refers to the same content or whether "the content viewing" lacks antecedent basis.
24. Applicant should check for any other problems in claims 1 and 2, e.g. "opportunity characteristics" (*e.g. in claim 1 lines 17, 22, 24 and 14. Also, does "the opportunity" in line 17 refer to the same subject as "opportunity characteristics"?*).
25. Through out the claims, applicant uses terms and phrases that are not well defined providing ambiguity in regard to the meaning of the claim language.
26. Specifically, the following terms/phrases are not understood:
- a. "content": it is not clear how content differs from the "opportunity",
 - b. "opportunity": the term is used through out the application, e.g. "...the receiver to exercise the opportunity..." and "...a content targeting opportunity..." in claim 1, "...based on the characteristics of the opportunity..." and "...the opportunity is based on the invocation of a function or group of functions..." in claim 2, etc.
 - c. "characteristic information about the viewer": claim 1,
 - d. "securely": e.g. "securely receiving", "securely storing", etc. : claim 1,
 - e. "any less-suitable": claim 2,

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- f. "... the content can cause the process not to select any content...": claim 6,
- g. "... can be located in whole or in part within one or more components of a receiver and/or to one or more devices on a network": claim 8,
- h. "extensible number of characteristics": claim 12,
- i. "the exercising opportunity": claim 17,
- j. "based on": claim 18,
- k. "including but not limited to": claims 14, 21-23,
- l. "content alternatives": claim 27,
- m. "airing through simultaneous substitution requirements": claim 29,
- n. "temporarily off air": claim 30,
- o. "methods other than the primary content transfer mechanism": claim 32,
- p. "black-out" and "black-out pattern": claim 35,
- q. "level of detail of detail": claim 37,
- r. "rental price": claim 38,
- s. "permission is available": claim 49,
- t. "potential content": claims 50-51, e.g. "receiving from content providers, potential content ...",
- u. "such as": claims in claims 51 and 53

27. Claims 48 and 49 are directed towards "determining which versions of the content the receiver is permitted to access". However, the specification provides no guidance in teaching how this limitation is accomplished. The term "permission" is

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recite in the claim language in regard to applications, users. The term "permission" that correlate with the term "receiver" seems to be more analogous of the term "ability".

28. Similarly, applicant does not disclose "determining if permission is available to sue storage accessible to the receiver with characteristics ...", the limitation recited in claim 49.

For purposes of further examination the phrase is treated as best understood.

29. The examiner provides mapping of the terms and phrases to the claim language; however, due to the great number of unclear terms applicant should check for the presence of the terms in other (than cited above) claims.

No new matter is allowed.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

30. Claims 1, 3-8, 12-13, 17-19, 21, 23-37, 39-40, 50 and 52 are rejected under 35

U.S.C. 102(e) as being anticipated by *Bandera et al.* (U.S. Patent No. 6332127).

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31. Due to the great number of terms/phrases that are not clear, the claim limitations are treated as best understood.

32. As per claims 1, 3, 24, 35, 52-53 *Bandera et al.* teach a receiver connected to one or more networks of a content targeting opportunity (*Fig. 1 object 21*). The receiver receives receiver's location information (*col. 4 lines 46-47*) and receives content from a Web server with an opportunity (*col. 2 lines 49-52*).

The receiver sends characteristic information about the viewer (*viewer location information*) included within a content request (*col. 4 lines 50-50*), and the web server dynamically generates the requested content (*col. 4 lines 61-63*). The web server utilizes the viewer's information to select an appropriate opportunity (*col. 7 lines 32-39*). The viewer executes an opportunity validation by selecting a validation anchor within an opportunity (*Fig. 5, objects 200, 2002, 204, 206 and 208, col. 8 lines 25-51*).

33. As per claim 4 selecting an opportunity results in receiving content.

34. Claim 5 is inherent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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35. Claims 2, 38, 48, 51, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bandera et al.* (U.S. Patent No. 6332127) in view of *Ginter et al.* (U.S. Patent No. 6237786).

36. *Bandera et al.* teach a method as discussed above.

37. As per claims 48, 51 and 53 *Bandera et al.* do not teach recording and reporting the fact that the content has been presented to a user.

38. *Ginter et al.* teach recording and reporting the fact that the content has been presented to a user (*Ginter et al.*, col. 292 lines 29-39).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to record and report the fact that the content has been presented to a user.

One of ordinary skill in the art would have been motivated to perform such a modification in order to provide additional content management capabilities, e.g. budgeting, auditing etc.

39. Furthermore, *Bandera et al.* do not teach determining which versions of the content the receiver is permitted to access (*claim 48*).

40. *Ginter et al.* teach controlled delivery of content versions (*Ginter et al.*, col. 193 lines 7-14).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement controlled delivery of content versions for motivation of benefit to restrict access to only authorized content.

Determining, which version of the content the receiver is permitted to access as well as running an opportunity matching process to determine, which accessible and

permitted versions of the content match the viewer, opportunity and content characteristic would be implicit.

41. As per claim 2 it is implicit that a viewer selects a content and opportunity more than once.

42. As per claim 38, *Bandera et al.* do not explicitly teach that the viewer's permission of the level of detail of detail to be reported is obtained by one or more of the following: an agreement at the time of acquisition of the receiver by the viewer, which may be obtained through a subsidized purchase of rental price, a reduction in the price of the service, or a credit towards specific services and a direct payment to the viewer.

43. Official Notice is taken that it is old and well-known practice to implement the viewer's permission of the level of detail of detail, wherein the level can be controlled within the receiver functions, and also to subsidize purchase of rental price for example. One of ordinary skill in the art at the time of applicant's invention would have been motivated to subsidize purchase of rental price in order to obtain the viewer's permission to report the level of detail of detail in order to motivate users to provide detail statistics which could be used in generating additional revenues.

44. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Bandera et al.* (U.S. Patent No. 6332127) in view of *Ginter et al.* (U.S. Patent No. 6237786) and in further view of *Pierre et al.* (U.S. Patent No. 6678463) and in light of *Windows NT* as illustrated by *Hadfield et al.* (Lee Hadfield, Dave Hater, Dave Bixler, "Windows NT Server 4 Security Handbook", 1997, ISBN: 078971213).

45. *Bandera et al.* in view of *Ginter et al.* teach method as discussed above.

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46. *Bandera et al.* in view of *Ginter et al.* do not teach determining if sufficient space is available on local storage, deleting content to make space available and acquiring and storing the content on the local storage.

47. *Pierre et al.* teach determining if sufficient space is available on local storage, deleting content to make space available and acquiring and storing the content on the local storage (*Pierre et al.*, col. 10 lines 15-19).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement determining if sufficient space is available on local storage, deleting content to make space available and acquiring and storing the content on the local storage. One of ordinary skill in the art would have been motivated to perform such a modification in order to accommodate requested content.

48. *Bandera et al.* in view of *Ginter et al.* do not teach determining if permission is available to use storage accessible to the receiver with characteristics suitable for real-time playback with predictable content access latency characteristics ("local storage").


49. However, determining if permission is available is well known in the art as illustrated by *Windows NT* (pg. 200-201).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize permissions to use storage as illustrated by *Windows NT*. One of ordinary skill in the art would have been motivated to implement permissions in order to prevent unauthorized use of the storage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature
7/19/15
Date

David Y. Jung
Primary Examiner

